

REMARKS

Reconsideration of the present application is respectfully requested. The application, as amended, includes claims 1, 2, 4, 9-11, 20-24, 43, 45-46, 48-50, 101, 103, 104, 106, 147-151, 153, 154, 202-205, 208-213 and 215-247 pending and under consideration. Claims 6-8, 12-19, 25-31, 38-42, 44, 166, 168 and 169 are also pending in the application but have been withdrawn from consideration pending final resolution of genus claims.

The Examiner is thanked for her courtesy in the telephonic interview of May 17, 2005 wherein the §112 support issues and the inherency issues raised in the outstanding Office Action were discussed. While agreement as to all claims was not explicitly reached, the undersigned pointed to portions of the specification which seemed to address the outstanding §112 issues. These and other sections of the specifications are noted below. Further, it was suggested that the art rejections of claim 1, 48 and 215 could be overcome by amending the claims to more positively recite the formation of an analytical device (claims 1 and 48) or chemical sensor (claim 215) and that the art rejections of claims 232 and 234 could be overcome if the claims were amended to recite a determining step. The respective claims are being amended along these lines. Reconsideration of the application and withdrawal of all rejections is respectfully requested.

Claim rejections: §112

“analytical device”

The Action asserts that the generic term “an analytical device” is not supported by the specification. Applicants respectfully disagree and direct the Examiner’s attention to, for example, page 1 lines 32-33 (“microanalytical materials and devices”) and page 2 lines 18-19 (“sorber materials that have ... specific chemical interactions required for their microanalytical function in

their particular applications which can be patterned on device structures.”) Furthermore, the Action acknowledges that the specification provides adequate written description support for “a chemical sensor, a separation membrane, a solid phase extraction device and a chromatograph,” and it is well settled that disclosure of several species within a genus can be adequate written description support for the genus. Accordingly, there is seen to be adequate written description support for the generic term “analytical device” and therefore the §112 rejections premised on this basis should be withdrawn.

“separation device”

Claims 223 and 225 stand rejection on the basis that “[a]lthough there is a [sic] support for a separation membrane, there is no support in the original disclosure for the generic term ‘a separation device’.” Applicants respectfully disagree and contend that the generic term is adequately supported. Nonetheless, to speed prosecution of the present case, the claims have been amended to recite a “separation membrane”, which the Action acknowledges is fully supported. Withdrawal of the rejection is therefore requested.

“preselecting a design”

With respect to independent claims 240 and 244, the Action asserts that there is inadequate support for “preselecting a design for the device and manufacturing the device according to the design.” Applicants respectfully disagree and point to, for example, page 23 lines 21-24 of the present specification as providing adequate support (“a sorbent film designed to be selective for some chemical species relative to other chemical species when exposed to such species.”). Nevertheless, in an effort to speed prosecution, claims 240 and 244 have been amended to eliminate the selection of a design as a stand alone step. Withdrawal of the rejection is respectfully requested.

Claim Rejections: §§102 and 103

The independent claims presently rejected based on the art are claims 1, 48, 215, 232 and 234. Based on the discussions in the May 17th interview, the undersigned believes that, as amended, these claims adequately define over the art. Withdrawal of the rejections is therefore respectfully requested.

With respect to claims 1 and 48, the Action states that Cavezzan and Oxman both would “inherently be able to operate as an analytical device.” However, none of the structures of either Cavezzan or Oxman are described to actually operate as an analytical device nor is there any suggestion in the art to incorporate the structures of Cavezzan or Oxman into an analytical device. As amended, independent claims 1 and 48 positively claim the formation of an analytical device. This limitation must be given patentable weight, and the rejections of claims 1 and 48 should be withdrawn.

Likewise, as amended, independent claim 215 positively claims the making of a chemical sensor. Cavezzan does not describe making a chemical sensor with his “film-forming organopolysiloxane composition.” The supporting references are not seen to cure this deficiency. Accordingly, the art rejection of claim 215 should be withdrawn.

Independent claims 232 and 234 stand rejected based on the assertion that the selecting steps were inherently taught by the art. While Applicants’ respectfully disagree with the Action’s failure to give patentable weight to the claimed reason for the selection (i.e. “based upon a determination that...”), claim 232 and 234 have been amended to expressly recite a determining step. These determining steps must be given patentable weight, and these steps are clearly not

taught or suggested by the references. Therefore, the rejections of claims 232 and 234 should be withdrawn.

CLOSING

In view of the above, Applicants respectfully submit that the present application, as amended and including pending claims 1, 2, 4, 6-31, 38-46, 48-50, 101, 103, 104, 106, 147-151, 153, 154, 166, 168, 169 202-205, 208-213, and 215-247, is in condition for allowance. Action to that end is respectfully requested.

Applicants also respectfully submit that, upon allowance of the claims currently pending and under consideration, it is appropriate for the Examiner to reinstate and allow the claims that were previously withdrawn from consideration as drawn to non-elected species (i.e., claims 6-8, 12-19, 25-31, 38-42, 44, 166, 168 and 169).

If there are any remaining issues that can be addressed telephonically, the Examiner is invited to contact the undersigned to discuss the same.

Respectfully submitted,

By 

John M. Bradshaw, Reg. No. 46,573
Woodard, Emhardt, Moriarty, McNett & Henry LLP
3700 Bank One Center Tower
111 Monument Circle
Indianapolis, IN 46204-5137
(317) 713-4950